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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,941	07/15/2003	David Whyte	034536-0321	6608

22428 7590 08/09/2005

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EXAMINER	
MONSHIPOURI, MARYAM	
ART UNIT	**PAPER NUMBER**
1653	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/618,941	WHYTE ET AL.	
	Examiner	Art Unit	
	Maryam Monshipouri	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-36 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-36 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-5, 26-29, drawn to isolated DNA sequences encoding novel kinases, vectors and host cells comprising said products, classified in class 435, subclass 252.3.

II. Claims 6-8, drawn to said kinases, classified in class 435, subclass 194.

III. Claims 9-11, drawn to antibodies , kits comprising said antibodies and hybridoma cells which produce said antibodies, classified in class 530, subclass 387.9.

IV. Claims 12-13, drawn to methods of identifying modulators of said kinases, classified in class 435, subclass 15.

V. Claims 14-20 and 36, drawn to methods of treatment utilizing said modulators, classified in class 514, subclass 789.

VI. Claims 21-25 , drawn to methods of detecting said kinases in a sample utilizing said nucleic acids, classified in class 435, subclass 6.

VII. Claims 30-35, drawn to transgenic mouse comprising said nucleic acids, cell lines derived from said mouse and methods of use of said transgenic animal, classified in class 800, subclass 8.

In addition to invention listed as Groups I-VII above, each invention is additionally directed to the following patentably distinct inventions of unrelated chemical structure and function. Applicant is advised to elect one invention from Groups I-VII and one from groups 1-64, simultaneously in response to this office action.

(1) SEQ ID NO:67 or DNA encoding it.

(2) SEQ ID NO:68 or DNA encoding it.

(3) SEWQ ID NO:69 or DNA encoding it.

(4) SEQ ID NO:70 or DNA encoding it.

(5) SEQ ID NO:71 or DNA encoding it.

(6) SEQ ID NO:72 or DNA encoding it.

(7) SEWQ ID NO:73 or DNA encoding it.

(8) SEQ ID NO:74 or DNA encoding it.

(9) SEQ ID NO:75 or DNA encoding it.

(10) SEWQ ID NO:76 or DNA encoding it.

(11) SEQ ID NO:77 or DNA encoding it.

(12) SEQ ID NO:78 or DNA encoding it.

(13) SEQ ID NO:79 or DNA encoding it.

(14) SEWQ ID NO:80 or DNA encoding

(15) SEQ ID NO:81 or DNA encoding it.

(16) SEQ ID NO:82 or DNA encoding it.

(17) SEWQ ID NO:83 or DNA encoding it.

(18) SEQ ID NO:84 or DNA encoding it.

(19) SEQ ID NO:85 or DNA encoding it.

(20) SEQ ID NO:86 or DNA encoding it.

(21) SEWQ ID NO:88 or DNA encoding it.

(22) SEQ ID NO:89 or DNA encoding it.

(23) SEQ ID NO:90 or DNA encoding it.

(24) SEWQ ID NO:91 or DNA encoding it.

(25) SEQ ID NO:92 or DNA encoding it.

(26) SEQ ID NO:93 or DNA encoding it.

(27) SEQ ID NO:94 or DNA encoding it.

(28) SEWQ ID NO:95 or DNA encoding

(29) SEQ ID NO:96 or DNA encoding it.

(30) SEQ ID NO:97 or DNA encoding it.

(31) SEWQ ID NO:98 or DNA encoding it.

(32) SEQ ID NO:99 or DNA encoding it.

(33) SEQ ID NO:100 or DNA encoding it.

(34) SEQ ID NO:101 or DNA encoding it.

(35) SEWQ ID NO:102 or DNA encoding it.

(36) SEQ ID NO:103 or DNA encoding it.

(37) SEQ ID NO:104 or DNA encoding it.

(38) SEWQ ID NO:105 or DNA encoding it.

(39) SEQ ID NO:106 or DNA encoding it.

(40) SEQ ID NO:107 or DNA encoding it.

(41) SEQ ID NO:108 or DNA encoding it.

(42) SEWQ ID NO:109 or DNA encoding

(43) SEQ ID NO:110 or DNA encoding it.

(44) SEQ ID NO:111 or DNA encoding it.

(45) SEWQ ID NO:112 or DNA encoding it.

(46) SEQ ID NO:113 or DNA encoding it.

(47) SEQ ID NO:114 or DNA encoding it.

(48) SEQ ID NO:115 or DNA encoding it.

(49) SEWQ ID NO:117 or DNA encoding it.

(50) SEQ ID NO:118 or DNA encoding it.

(51) SEQ ID NO:119 or DNA encoding it.

(52) SEWQ ID NO:120 or DNA encoding it.

(53) SEQ ID NO:121 or DNA encoding it.

(54) SEQ ID NO:122 or DNA encoding it.

(55) SEQ ID NO: 123 or DNA encoding it.

(56) SEWQ ID NO:124 or DNA encoding

(57) SEWQ ID NO:125 or DNA encoding it.

(58) SEQ ID NO:126 or DNA encoding it.

(59) SEQ ID NO:127 or DNA encoding it.

(60) SEWQ ID NO:128 or DNA encoding it.

(61) SEQ ID NO:129 or DNA encoding it.

(62) SEQ ID NO:130 or DNA encoding it.

(63) SEQ ID NO: 131 or DNA encoding it.

(64) SEWQ ID NO:132 or DNA encoding

The inventions are distinct, each from the other because of the following reasons:

The DNA of Group I, the polypeptides of Group II, the antibodies of Group III and the transgenic animals of Group VII are patentably distinct each from the other because each invention is directed to a product of unrelated chemical structure and function.

Inventions I and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the DNA of Group I may be used for recomabinant expression of kinases which is a totally different method than that of Group VI.

The DNA of Group I is unrelated to any of the methods of Groups IV and V Because said product is neither made nor used by nay of said methods.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the kinases of Group II may be used in antibody preparation which is a totally different method than that of Group IV.

The polypeptides of Group II are unrelated to any of the methods of Groups V or VI because said products are neither made nor used by any of said methods.

The antibodies of Group III and the transgenic mice of Group VII are each unrelated to any of the methods of Groups IV-VI because said products are neither made nor used by any of said methods.

The inventions of Groups IV-VI are each patentably distinct from the other because each method has different steps and different end-points.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or other wise include all the limitations of the allowable product claim will be rejoined in accordance with the provision of MPEP section 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and he rejoined process will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104, Thus, to be allowable, the rejoined clams must meet all the criteria for patentability including the requirement of 35 U.S.C. 101, 102, 103 and 112. Until an alerted product claims is

found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined, See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. section 103(b)," 1184 O.G. 86(March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include limitations of the product claim. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP section 804.01.

A telephone call was made to Ms. Beth A. Burrous on 8/2/2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maryam Monshipouri whose telephone number is (571) 272-0932. The examiner can normally be reached on 7:00 a.m to 4:30 p.m. except for alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weber Jon P. can be reached on (571) 272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Monshipouri

Maryam Monshipouri Ph.D.

Primary Examiner